

Intel Corporation  
4030 Lafayette Center Drive  
Chantilly, VA 20151

Page 1 of 7

***Urgent and Confidential***

Date: November 7, 2005

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**TO:** USPTO  
Examiner James K. Trujillo  
Art Unit 2116  
Fax Number 571-273-8300

**FROM:** Paul E. Steiner  
Fax Number 703-633-3303  
Phone Number 703-633-6830

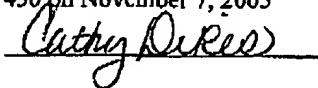
**SUBJECT:** Application Number 09/863,103  
Inventor(s) John P. Lambino, et al.  
Date Filed May 22, 2001  
Docket Number P11071  
Title Firmware Upgrade Using Address Conversion

**INCLUDED IN THIS TRANSMISSION:**

Fax Cover Sheet	1 page
Transmittal	1 page
Fee Transmittal	1 page
Notice of Appeal	1 page
Pre-Appeal Brief Request	2 pages
Extension of Time Request	1 page

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Cathy Dikes

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PTO/SB/21 (09-04)

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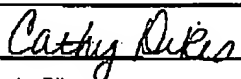
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<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	09/863,103	
	Filing Date	May 22, 2001	
	First Named Inventor	John P. Lambino, et al.	
	Art Unit	2116	
	Examiner Name	James K. Trujillo	
Total Number of Pages in This Submission	7	Attorney Docket Number	P11071

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input checked="" type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Fax cover sheet Pre-Appeal Request
Remarks _____		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	Intel Americas		
Signature	/Paul E. Steiner/		
Printed name	Paul E. Steiner		
Date	November 7, 2005	Reg. No.	41,326

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:			
Signature			
Typed or printed name	Cathy Dikes	Date	November 7, 2005

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 36 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PTO/SB/17 (12-04v2)

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Effective on 12/08/2004.  
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).**FEE TRANSMITTAL**  
**For FY 2005**☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$) 620.00**Complete If Known**

Application Number 09/883,103

Filing Date May 22, 2001

First Named Inventor John H. LIEDER

Examiner Name James K. Trujillo

Art Unit 2116

Attorney Docket No. P11071

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**CENTRAL FAX CENTER****NOV 07 2005****METHOD OF PAYMENT** (check all that apply)

- ☐ Check ☐ Credit Card ☐ Money Order ☐ Nonc ☐ Other (please identify): \_\_\_\_\_
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- For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)
- ☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee
- ☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

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**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

**2. EXCESS CLAIM FEES****Fee Description**

Each claim over 20 (including Reissues)

Each independent claim over 3 (including Reissues)

Multiple dependent claims

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
- 20 or HP =	0	50.00	0

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
- 3 or HP =	0	200.00	0

HP = highest number of independent claims paid for, if greater than 3.

Fee (\$)	Small Entity Fee (\$)
50	25
200	100
360	180

Fee (\$)	Fee Paid (\$)

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 =		/ 50 =	(round up to a whole number) x	

**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): Extension of Time (\$120) Notice of Appeal (\$500)

**Fees Paid (\$)**

620.00

**SUBMITTED BY**

Signature	/Paul E. Steiner/	Registration No. (Attorney/Agent)	41,326	Telephone	703-633-6830
Name (Print/Type)	Paul E. Steiner			Date	November 7, 2005

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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NOV 07 2005

In re patent application of:

John P. LAMBINO, et al.

Serial No.: 09/863,103

Group Art Unit: 2116

Filed: May 22, 2001

Examiner: J. Trujillo

FOR: FIRMWARE UPGRADE USING ADDRESS CONVERSION

## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop After Final  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In accordance with the procedures outlined in the Official Gazette published July 12, 2005, applicants respectfully request review of the following clear errors in the final office mailed July 6, 2005, in connection with the above-identified application.

With respect to independent claims 1, 6, 12, 17, 20, and 24, see applicants' arguments on pages 1-4 of applicants' response filed September 6, 2005. In particular, the Examiner admits that Miller teaches only setting a flag. The setting of a flag is different from and does not teach or suggest modifying an address bit of the execution address. The Examiner admits that Miller teaches only maintaining the state of the flag. The state of the flag does not correspond to the state of the address line A16. Miller does not teach or suggest that the state of the address line A16 is maintained during a power cycle.

With respect to claims 10-11 and 22-23, see applicants' arguments on pages 4-5 of applicants' response filed September 6, 2005. In particular, the Examiner does not meet the burden of proof required to establish inherency. Contrary to the Examiner's

P11071

09/863,103

understanding set forth in the Advisory Action mailed September 21, 2005, the burden of proof for relying on inherency is the same for both § 102 and § 103 rejections.

In view of the foregoing, favorable reconsideration and withdrawal of the rejections is respectfully requested. Early notification of the same is earnestly solicited. If there are any questions regarding the present application, the Review Panel is invited to contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,

November 7, 2005

Date

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2